

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 1-37 are cancelled, claims 38-47 remain in this application as amended herein, and claims 48-52 are added. Accordingly, claims 38-52 are submitted for the Examiner's reconsideration.

The specification has been amended to better conform to the requirements of U.S. practice. No new matter has been added by these amendments.

Claims 39-42 and 44-47 have been amended solely to have the claims better conform to the requirements of U.S. practice. None of these amendments is intended to narrow the scope of any of these claims, and no new matter has been added by these amendments.

In the Office Action, claims 38-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginter (U.S. Patent No. 5,892,900) in view of Stefik (U.S. Patent No. 5,629,980). Applicants submit that the claims are patentably distinguishable over the relied on sections of the references.

As amended herein, claim 38 recites:

at a time subsequent to the transmitting of the encrypted content and the added content ID through the user terminal to the player,

receiving a request for the content key from the player through the user terminal, the request including the content ID, and

in response thereto, transmitting the content key and the use condition through the user terminal to the player.

(Emphasis added.) Neither the relied on sections of Ginter nor the relied on sections of Stefik disclose or suggest receiving a request for a content key and, in response thereto, transmitting a content key and a use condition at a time subsequent to transmitting encrypted content and added content ID.

Rather, the relied on sections of Ginter describe permissions records ("PERCs"), which control how content may be used and which contain keys to decrypt the content and/or to decrypt keys that can be used to decrypt the content, that are encapsulated together with the content in the same object. (See Figs. 17-19, col.134 11.29-39, col.155 11.37-51, and col.158 11.58-64.) Namely, the content and the permissions records are transmitted together at the same time. Such sections of Ginter are not concerned with receiving a request for permissions records at a time subsequent to transmitting encrypted content and transmitting permissions records at a time subsequent to transmitting encrypted content. Hence, the relied on sections of Ginter do not disclose or suggest receiving a request for a content key at a time subsequent to transmitting encrypted content, and the relied on sections of Ginter do not disclose or suggest transmitting a content key and a use condition at a time subsequent to transmitting encrypted content.

The relied on sections of Stefik do not remedy the deficiencies of the relied on sections of Ginter. Rather, such sections of Stefik describe a repository which is comprised of a storage means that stores a digital work and its attached usage rights and which, in responding to a request to access a digital work, decrypts the work contents, data, and usage rights and transmits same to the requester. (See col.4 11.6-7 and 10-13, and col.38 11.6-9 and 40-43.) The relied on sections of Stefik neither disclose nor suggest transmitting usage rights at a time subsequent to transmitting encrypted content.

It follows, for at least these reasons, that neither the relied on sections of Ginter nor the relied on sections of Stefik, whether taken alone or in combination, disclose or suggest the method set out in claim 38. Claim 38 is therefore patentably distinct and unobvious over the relied on references.

Independent claim 43 has been amended to recite features similar to those set out in the above excerpts of claim 38 and is therefore patentably distinct and unobvious over the relied on sections of Ginter and Stefik for at least the same reasons.

Claims 39-42 depend from claim 38, and claims 44-47 depend from claim 43. Therefore, each of these claims is distinguishable over the relied on art for at least the same reasons as the claim from which it depends.

Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 103(a).

The Examiner also contends that "the 'means for' phrases [in claims 43-47] do not invoke 35 U.S.C. 112 6th paragraph" but does not provide any explanation as to why the Examiner takes this position. M.P.E.P. § 2181 I clearly requires the Examiner to provide such explanation. As set out therein:

It is necessary to decide on an element by element basis whether 35 U.S.C. 112, sixth paragraph, applies. ...

...If a claim limitation does include the phrase "means for" or "step for," that is, the first prong of the 3-prong analysis is met, but the examiner determines that either the second prong or the third prong of the 3-prong analysis is not met, then in these situations, the examiner must include a statement in the Office action explaining the reasons why a claim limitation which uses the phrase "means for" or "step for" is not being treated under 35 U.S.C. 112, sixth paragraph.

(Emphasis added.) Applicant respectfully requests that the Examiner explain the reasons for the Examiner's assertion that the elements of claims 43-47 do not invoke 35 U.S.C. § 112, sixth paragraph and identify the claim elements for which 35 U.S.C. § 112, sixth paragraph does not apply.

The Office Action also indicates that "if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner

respectfully requests Applicant(s) to expressly state their desire on the record."

The Examiner's request is unclear because it is the wording of the claim element that determines whether 35 U.S.C. § 112, sixth paragraph is invoked, rather than the Applicant's express invocation. (See M.P.E.P. § 2181 I.) Applicant therefore respectfully requests that the Examiner clarify what is being required by the Examiner.

Moreover, even assuming that the Examiner is actually requiring Applicant's express invocation, M.P.E.P. § 2181 I sets forth the following presumption:

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

(Emphasis added.) In view of this presumption, it is not clear why such express invocation would be needed.

New claim 48 calls for features similar to those set out in the above excerpts of claim 38, and new claims 49-52 depend from claim 48. Therefore, each of these claims is distinguishable over the relied on art for at least the same reasons. New claims 48-52 are analogous to claims 38-42, respectively, and 43-47, respectively, and are similarly supported.

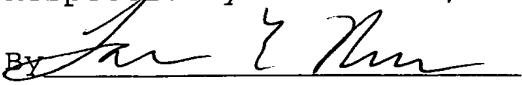
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at

(908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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